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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,935	04/06/2001	Paolo Benedetti	027650-921	7897

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EXAMINER

GERRITY, STEPHEN FRANCIS

ART UNIT	PAPER NUMBER
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3721

9

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,935

Applicant(s)

BENEDETTI ET AL.

Examiner

Stephen F. Gerrity

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 12 and 13 is/are allowed.
- 6) ☒ Claim(s) 1, 3-11 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3721

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3, line 10, the language "comprising at least one layer of electrically conductive barrier material" renders the claim ambiguous because it is unclear from the claim which element or feature includes the electrically conductive barrier material. It appears as though the amendment of claim 3 has resulted in the above language being separated from the language "... from a tube of heat seal sheet packing material ..." found in line 3 of the claim. It is suggested that line 3 of the claim be amended to insert the language "comprising at least one layer of electrically conductive barrier material" after the language "sheet packing material", and that the language "comprising at least one layer of electrically conductive barrier material" be deleted from line 10.

Art Unit: 3721

Claim 6, line 13, the language "comprising at least one layer of electrically conductive barrier material" renders the claim ambiguous because it is unclear from the claim which element or feature includes the electrically conductive barrier material. This claim has the same ambiguity as claim 3, and should perhaps be amended in a similar manner to that as set forth above with regard to claim 3.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 5, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenawalt et al. (US 4,109,792).

Regarding claims 1, 4 and 5, the recitation in each claim "... and fill continuously ..." has not been given patentable weight because it appears in the preamble of each claim, and it has been held that a preamble is denied the effect of a limitation where the portion of the claim following the preamble is a self-contained description of the invention not depending for

Art Unit: 3721

completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

Allowable Subject Matter

5. Claims 2, 12 and 13 are allowed.

6. Claims 3 and 6-10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action ~~and to include all of the limitations of the base claim and any intervening claims.~~

Response to Arguments

7. Applicant's arguments filed 29 May 2003 have been fully considered but they are not persuasive.

Applicant has principally argued that claims 1, 4, 5, 11 and 14 should not be rejected under 35 U.S.C. 102(b) because these claims recite "... and filled continuously ..." and the applied reference does not fill continuously but rather periodically. This argument has been fully considered but is deemed not persuasive because the language "... and filled continuously ..." is found in the preamble of each of the independent claims 1, 4 and 5.

A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not

Art Unit: 3721

depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

[T]he preamble has been denied the effect of a limitation where ... the claim or [interference] count apart from the introductory clause completely defined the subject matter [of the invention], and the preamble merely stated a purpose or intended use of that subject matter. On the other hand, in those ... cases where the preamble to the claim or count was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or count. In the latter class of cases, the preamble was considered necessary to give life, meaning and vitality to the claims or counts. Kropa v. Robie, 187 F.2d 150, 152 [88 USPQ 478] (C.C.P.A. 1951) (collecting cases), quoted in Bell Communications Res., Inc., 55 F.3d at 620-21.

"In general, a preamble limits the [claimed] invention if it recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim." Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808,

Art Unit: 3721

62 USPQ2d 1781, 1784 (Fed. Cir. 2002) (quoting Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). "[A] claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects." Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention. See, e.g., Electro Sci. Indus. v. Dynamic Details, Inc., 307 F.3d 1343, 1348, 64 USPQ2d 1781, 1783 (Fed. Cir. 2002); Rapoport v. Dement, 254 F.3d 1053, 1059, 59 USPQ2d 1215, 1219 (Fed. Cir. 2001); Pitney Bowes, 182 F.3d at 1306, 51 USPQ2d at 1166. On the other hand, "[i]f the body of the claim sets out the complete invention," then the language of the preamble may be superfluous. Schumer v. Lab. Computer Sys., Inc., 308 F.3d 1304, 1310, 64 USPQ2d 1832, 1837 (Fed. Cir. 2002); Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1373-74, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001)." Quoted from Eaton

Art Unit: 3721

Corp. v. Rockwell International Corp., 66 USPQ2d 1271, 1276
(Fed. Cir. 2003).

In this case the body of each of the independent claims 1, 4 and 5 is able to stand alone as a complete invention. Additionally, in this case, the preamble of each of the independent claims 1, 4 and 5 is not needed to provide antecedent basis for a recitation in the body of each of the independent claims 1, 4 and 5 regarding the filling of the tube. Furthermore, in this case, the preamble of each of the independent claims 1, 4 and 5 merely provides a statement of the purpose of the invention, and lastly, the preamble of each of the independent claims 1, 4 and 5 is not essential to understand the limitations or terms in the body of each of the independent claims.

Finally, note that applicant's argument that independent claims 1, 4 and 5 of the present application refer to a method and unit "wherein the cutting operation is performed before the sealing operation while the tube is continuously filled with the pourable food product" (page 12 of the amendment) is not deemed persuasive because that language is not found in the claims nor would it be required by the claims.


Art Unit: 3721

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Stephen Gerrity**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Rinaldi Rada**, may be contacted. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Tech. Center 3700** receptionist.


Stephen F. Gerrity
Primary Examiner
Art Unit 3721

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